



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,133	06/14/2001	Nicholas T. Hariton	152853-0009	8097

7590 02/10/2005
IRELL & MANELLA LLP
Suite 900
1800 Avenue of the Stars
Los Angeles, CA 90067

EXAMINER

KE, PENG

ART UNIT	PAPER NUMBER
----------	--------------

2174

DATE MAILED: 02/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,133

Applicant(s)

HARITON, NICHOLAS T.

Examiner

Peng Ke

Art Unit

2174

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-94 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This action is responsive to communications: Amendment, filed on 9/17/04.

This action is final.

Claims 1-94 are pending in this application. Claims 1, 20, 38, 55, 71, and 84 are independent claims. In the Amendment, filed on 9/17/04, claims 1, 20, 31-94 were amended.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 – 4, 6 – 8, 10, 12 – 25, 27 – 29, 31, 33 – 41, 43 – 45, 47, 49 – 60, 62 – 64, 66, 68 – 72, 74 – 76, 78, 81 – 85, 87 – 89, 91 and 94, are rejected under 35 U.S.C. 102(e) as being anticipated by Plantz et al., U.S. Patent No. 6,088,702.

As per claim 1, Plantz et al. (“Plantz”) teaches a method for preparing a presentation, comprising:

connecting a plurality of geographically dispersed contributors to a controller through a network to concurrently (column 5, lines 1-4) collaborate to prepare the presentation (see Plantz, column 4, lines 64 – column 5, lines 4);

Art Unit: 2174

allowing the contributors to propose contributions to the presentation, the proposed contributions residing on storage devices under the control of the contributors (see Plantz, column 7, lines 52 – 55; it is inherent that the proposed contributions reside on the contributor storage devices because they are uploaded from the user's computer to the GPS);

making the proposed contributions available for viewing and comment by the contributors (see Plantz, column 5, lines 18 – 20);

allowing the controller to select one or more of the proposed contributions (see Plantz, column 10, lines 25 – 29; the examiner interprets an editor to be a controller); and

providing the controller access through the network to the storage devices to retrieve the selected contributions for inclusion into the presentation (see Plantz, column 10, lines 20 – 29).

As per claim 2, which is dependent on claim 1, Plantz teaches the method of claim 1 (see rejection above). Plantz further teaches the method of claim 1, wherein providing access to the storage devices further comprises:

transferring a selected contribution through the network to the controller for inclusion in the presentation (see Plantz, column 10, lines 25 – 29).

As per claim 3, which is dependent on claim 2, Plantz teaches the method of claim 2 (see rejection above). Plantz further teaches the method of claim 2, wherein transferring a selected contribution comprises:

transferring a selected contribution from a contributor to the controller through the network for inclusion in the presentation (see Plantz, column 10, lines 20 – 29; it is inherent that

the editor downloads the edited segment of the document to scan for approval for inclusion into the document).

As per claim 4, which is dependent on claim 2, Plantz teaches the method of claim 2 (see rejection above). Plantz further teaches the method of claim 2, wherein transferring a selected contribution comprises:

transferring a selected contribution through the network from a storage device to the controller for inclusion in the presentation (see Plantz, column 10, lines 20 – 29; it is inherent that the segment of the document selected by the editor is stored on a storage device).

As per claim 6, which is dependent on claim 2, Plantz teaches the method of claim 2 (see rejection above). Plantz further teaches the method of claim 2, wherein connecting the contributors to the controller further comprises:

connecting the contributors to the controller to provide instructions to the controller for preparing the presentation (see Plantz, column 5, lines 10 – 13, column 7, lines 52 – 55 and column 10, lines 18 - 20; the examiner interprets uploading data to the project for assembly by an author and indicating a topic, subtopic or chapter as being completed by an author as instructions for preparing the document).

As per claim 7, which is dependent on claim 6, Plantz teaches the method of claim 6 (see rejection above). Plantz further teaches the method of claim 6, wherein connecting the contributors to the controller to provide instructions to the controller comprises:

connecting the contributors to the controller to provide instructions to the controller to prepare a presentation script identifying the selected contributions to be included in the presentation (see Plantz, column 5, lines 10 – 13 and column 10, lines 50 – 57).

As per claim 8, which is dependent on claim 7, Plantz teaches the method of claim 7 (see rejection above). Plantz further teaches the method of claim 7, wherein the script includes a path for retrieving a selected contribution through the network from a storage device (see Plantz, column 10, lines 25 – 29; it is inherent that a path to the segment of the document that the editor has selected to download is used when the editor downloads the document).

As per claim 10, which is dependent on claim 2, Plantz teaches the method of claim 2 (see rejection above). Plantz further teaches the method of claim 2, wherein providing access to the storage devices comprises:

providing a path for retrieving a contribution through the network from a storage device (see Plantz, column 10, lines 25 – 29; it is inherent that a path to the segment of the document that the editor has selected to download is used when the editor downloads the document).

As per claim 12, which is dependent on claim 10, Plantz teaches the method of claim 10 (see rejection above). Plantz further teaches the method of claim 10, wherein the network is selected from the group of networks comprising the Internet, intranets, and local area networks (see Plantz, column 4, line 64 – line 3).

Art Unit: 2174

As per claim 13, which is dependent on claim 1, Plantz teaches the method of claim 1 (see rejection above). Plantz further teaches the method of claim 1, wherein the contributions are selected from the group of contributions comprising graphics, text, video, and audio (see Plantz, column 5, lines 36 – 39).

As per claim 14, which is dependent on claim 1, Plantz teaches the method of claim 1 (see rejection above). Plantz further teaches the method of claim 1, wherein the contributors are persons communicating with the controller through terminals connected to the network (see Plantz, column 7, lines 12 – 27).

As per claim 15, which is dependent on claim 14, Plantz teaches the method of claim 14 (see rejection above). Plantz further teaches the method of claim 14, wherein the controller is a person communicating with the contributors through a terminal connected to the network (see Plantz, column 7, lines 12 – 27).

As per claim 16, which is dependent on claim 15, Plantz teaches the method of claim 15 (see rejection above). Plantz further teaches the method of claim 15, wherein the presentation is prepared on the controller terminal (see column 7, lines 37 – 43).

As per claim 17, which is dependent on claim 1, Plantz teaches the method of claim 1 (see rejection above). Plantz further teaches the method of claim 1, further comprising: displaying the presentation (see Plantz, column 7, lines 55 – 58).

As per claim 18, which is dependent on claim 17, Plantz teaches the method of claim 17 (see rejection above). Plantz further the method of claim 17, wherein displaying the presentation comprises:

retrieving a selected contribution from the respective storage device immediately prior to displaying the selected contribution (see Plantz, column 8, lines 32 – 41; it is inherent that the document is downloaded before it is displayed).

As per claim 19, which is dependent on claim 18, Plantz teaches the method of claim 18 (see rejection above). Plantz further teaches the method of claim 18, wherein displaying the presentation further comprises:

providing access through the network to view the presentation (see Plantz, column 8, lines 32 – 41).

As per claims 20 – 22, they are of similar scope to claims 17 – 19 respectively and are rejected under the same rationale as claims 17 – 19 respectively (see rejections above).

As per claims 23 – 25, 27 – 29, 31, and 33 – 37, they are of similar scope to claims 2 – 4, 6 – 8, 10, and 12 – 19 respectively and are rejected under the same rationale respectively (see rejections above).

With respect to claim 38, it is similar in scope to claim 1 (see rejection above) with an additional claimed controller terminal for connecting through a network to a plurality of geographically dispersed contributor terminals to allow contributors to collaborate to prepare the presentation and a controller storage device connected to the controller terminal for storing the presentation and one or more of the selected contributions.

Plantz teaches controller terminal for connecting through a network to a plurality of geographically dispersed contributor terminals to allow contributors to collaborate to prepare the presentation (see Plantz, column 4, lines 64 – 4; it is inherent that all users, including the controller are connected through terminals), and

the method of claim 1 and further teaches a controller storage device connected to the controller terminal for storing the presentation and one or more of the selected contributions (see Plantz, column 6, lines 47 – 53).

As per claims 39 – 41 and 43 – 45 they are of similar scope to claims 2 – 4 and 6 – 8 respectively and are rejected under the same rationale respectively (see rejections above), including the additional subject matter in claim 38 (see rejection above).

As per claim 47, it is of similar scope to claims 8 and is rejected under the same rationale as claims 8 (see rejections above), including the additional subject matter in claim 38 (see rejection above).

Art Unit: 2174

As per claims 49 and 50, they are of similar scope to claims 12 and 13 respectively and are rejected under the same rationale as claims 12 and 13 respectively (see rejections above), including the additional subject matter in claim 38 (see rejection above).

As per claims 51 – 54 they are of similar scope to claims 16 – 19 respectively and are rejected under the same rationale as claims 16 – 19 respectively (see rejections above), including the additional subject matter in claim 38 (see rejection above).

As per claim 55, it is of similar scope to claim 52 and is rejected under the same rationale as claim 52 (see rejection above).

As per claims 56 and 57, they are of similar scope to claims 53 and 54 respectively and are rejected under the same rationale as claims 53 and 54 respectively.

As per claims 58 – 60, 62 – 64, 66, and 68 – 70, they are of similar scope to claims 39 – 41, 43 – 45, 47, and 49 – 51 respectively and are rejected under the same rationale respectively (see rejections above).

With respect to claim 71, it is similar in scope to claim 1 (see rejection above) with the additional claimed steps of transferring one or more contributions from the storage devices to the

controller immediately prior to display; and displaying the transferred contributions as part of the presentation.

Plantz teaches transferring one or more contributions from the storage devices to the controller immediately prior to display (see Plantz, column 8, lines 32 – 41; it is inherent that the document is downloaded before it is displayed);

and displaying the transferred contributions as part of the presentation (see Plantz, column 10, lines 20 – 25; the examiner interprets displaying those sections of the document that have been edited by other editors as transferred contributions because it is inherent that they were transferred from another user to the GPS).

As per claim 72, it is of similar scope to claim 19 and is rejected under the same rationale as claim 19 (see rejection above) including the additional subject matter in claim 71 (see rejection above).

As per claims 74 – 76, 78, and 81 – 83, they are of similar scope to claims 6 – 8, 10, and 13 – 15 respectively and are rejected under the same rationale respectively (see rejections above), including the additional subject matter in claim 71 (see rejection above).

With respect to claim 84, it is similar in scope to claim 38 (see rejection above) with the additional claimed step to retrieve one or more contributions for inclusion into the presentation immediately prior to display and to display the retrieved contributions as part of the presentation.

Plantz teaches to retrieve one or more contributions for inclusion into the presentation immediately prior to display (see Plantz, column 8, lines 32 – 41; it is inherent that the document is downloaded before it is displayed), and

to display the retrieved contributions as part of the presentation (see Plantz, column 10, lines 20 – 25; the examiner interprets displaying those sections of the document that have been edited by other editors as transferred contributions because it is inherent that they were transferred from another user to the GPS).

As per claim 85, it is of similar scope to claim 19 and is rejected under the same rationale as claim 19 (see rejection above) including the additional subject matter in claim 84 (see rejection above).

As per claims 87 – 89, 91, and 94, they are of similar scope to claims 6 – 8, 10, and 13 respectively and are rejected under the same rationale as claims 5 – 13 respectively (see rejections above), including the additional subject matter in claim 84 (see rejection above).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 9, 11, 26, 30, 32, 42, 46, 48, 61, 65, 67, 73, 77, 79, 80, 86, 90, 92 and 93 are rejected under 35 U.S.C. 103(a) as being unpatentable over Plantz et al., U.S. Patent No. 6,088,702 in view of Arcuri et al., U.S. Patent No. 6,121,968.

As per claim 5, which is dependent on claim 4, Plantz teaches the method of claim 4 (see rejection above). Plantz teaches a storage system (see Plantz, column 6, line 42) and a computer system that stores data (see Plantz, column 8, lines 3 – 6). Plantz does not teach the method of claim 4, wherein the storage devices are selected from the group of storage devices comprising hard drives, optical drives, magnetic tape drives, and magneto-optical drives. Arcuri et al. ("Arcuri") teaches wherein the storage devices are selected from the group of storage devices comprising hard drives, optical drives, magnetic tape drives, and magneto-optical drives (see Arcuri, column 6, lines 25 – 39). It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the method of Arcuri with the method of Plantz in order to allow for non-volatile storage of information.

As per claims 9, 11, 26, 30, 32, 42, 46, 48, 61, 65, 67, 73, 77, 79, 86, 90, and 92, they are

Art Unit: 2174

of similar scope to claim 5 and are rejected under the same rationale (see rejection above).

As per claim 80, which is dependent on claim 79, Plantz teaches the method of claim 79 (see rejection above). Plantz further teaches the method of claim 79, wherein the network is selected from the group of networks comprising the Internet, intranets, and local area networks (see Plantz, column 4, line 64 – line 3).

As per claim 93, which is dependent on claim 92, it is of similar scope to claim 80 and is rejected under the same rationale as claim 80 (see rejection above).

Response to Argument

Applicant's arguments filed on 9/17/04 have been fully considered but they are not persuasive.

Applicant's arguments focused on the following:

A) Applicant argues that Plantz fails to teach a system that allows authors to concurrently collaborate to edit or prepare the presentation.

A) Examiner disagrees. During patent examination, the pending claims must be "given *>their< broadest reasonable interpretation consistent with the specification." > In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner

Art Unit: 2174

reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969)

In this case, the claim recites a feature that connects “a plurality of geographically dispersed contributor to a controller through a network to concurrently collaborate to prepare the presentation”, and Plantz teaches this limitation by allowing multiple users to simultaneously work on the same projects” (col. 5, lines 3-5) ”through the Internet or other networked computing environment.” (col. 5, lines 1-3)

B) Applicant argues that Plantz fails to teach a system that includes a path for retrieving a selected contribution through the network.

B) Examiner disagrees. Plantz teaches a system that retrieves the projects through URL, which is an address or path that is used to locate a file on the Internet. (col. 7, lines 65-col. Lines

6) Examiner interprets URL to be the path.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peng Ke whose telephone number is (571) 272-4062. The examiner can normally be reached on M-Th and Alternate Fridays 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kristine L Kincaid can be reached on (571) 272-4063. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Peng Ke

Kristine Kincaid
KRISTINE KINCAID
SUPERVISOR, PATENT EXAMINER
TECHNOLOGY CENTER 2100